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MEDTRONIC, INC.			JOHNSON III, HENRY M	
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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DAVID E. FRANCISCELLI, SCOTT E. JAHNS, and
JAMES R. KEOGH

Appeal 2009-006049
Application 10/792,178
Technology Center 3700

Before: WILLIAM F. PATE III, STEFAN STAICOVICI, and
FRED A. SILVERBERG, *Administrative Patent Judges*.

PATE III, *Administrative Patent Judge*.

DECISION ON APPEAL¹

¹ The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, or for filing a request for rehearing, as recited in 37 C.F.R. § 41.52, begins to run from the “MAIL DATE” (paper delivery mode) or the “NOTIFICATION DATE” (electronic delivery mode) shown on the PTOL-90A cover letter attached to this decision.

STATEMENT OF CASE

Appellants appeal under 35 U.S.C. § 134 from a rejection of claims 25-33. We have jurisdiction under 35 U.S.C. § 6(b).

We reverse and enter a new ground of rejection under 37 C.F.R. § 41.50(b).

The claims are directed to a vibration sensitive ablation device and method. Claim 25, reproduced below, is illustrative of the claimed subject matter:

25. A method of ablating organic tissue, comprising:
 - positioning an electrode adjacent the organic tissue;
 - supplying electrical power to the electrode to effect ablation of the organic tissue;
 - sensing with a sensor positioned adjacent the electrode the vibration of the organic tissue being ablated wherein the vibration is self-generated in the organic tissue in response to the ablation; and
 - reducing power to the electrode when the vibration reaches a given value.

REFERENCES

The prior art relied upon by the Examiner in rejecting the claims on appeal is:

Nardella	US 5,334,193	Aug. 2, 1994
Nardella	US 5,733,281	Mar. 31, 1998

REJECTIONS

Claims 25, 26, and 28-33 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Nardella '281. Ans. 2.

Claim 27 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Nardella '281, and Nardella '193. Ans. 3.

OPINION

We have carefully reviewed the rejections on appeal in light of the arguments of the Appellants and the Examiner. As a result of this review, we have determined that the Examiner has established that claims 25, 26, and 28-33 lack novelty over the Nardella '281 patent and that claim 27 lacks novelty over the Nardella '281 and Nardella '193 patents. However, we denote this decision as a new ground of rejection for reasons discussed *infra*.

We are generally in agreement with Appellants' argument on page 7 of the Brief that Nardella '281 uses an ultrasonic oscillator which senses reflected waves off the tissue to detect steam or other gases. Consequently, we agree that the oscillator does not receive only vibrations of the organic tissue which are self-generated in response to the ablation. Therefore, the Examiner's rejection under § 102 based on this embodiment is reversed.

However, on page 4 of the Examiner's Answer, the Examiner points to the microphone embodiment of Nardella '281. The microphone receives vibrations of acoustic waves self-generated by the tissue and communicates these waves not only to a speaker 180 but also by conductor 188 to control the RF generator. Nardella '281 col. 8, l. 61 - col. 9, l. 31. Nardella '281 makes clear that the microphone is responding, not to the presence of steam, but to the noise generated when steam is created. *See id.*; col. 9, ll. 32-48.

Appellants argue in the Brief that the ultrasonic embodiment of Nardella '281 does not detect the self-noise generated by the tissue during the ablation process. As noted above, the microphone embodiment of Nardella '281 is responding to the noise generated in the tissue by the ablation process. Appellants' other argument in the Brief is that the ultrasonic oscillator embodiment of Nardella '281 is focused on detecting

Appeal 2009-006049
Application 10/792,178

the presence of steam or gases in the ablated tissue. Here again, the microphone embodiment of Nardella '281 does not detect the presence of steam or gases. It is responding to the vibrations or noise created in the tissue during the ablation process.

NEW GROUND OF REJECTION

Inasmuch as the reliance on the microphone embodiment of Nardella '281 appeared for the first time in the Examiner's Answer and was not denominated a new ground of rejection, an affirmance based on this embodiment raises questions of procedural due process. Accordingly, we have chosen to denominate our decision as a new ground of rejection to allow Appellants an opportunity to respond.

With respect to the 35 U.S.C. § 103 rejection of claim 27, Appellants have chosen not to argue this claim separately. Therefore, claim 27, although rejected under 35 U.S.C. § 103, falls with claim 25 since Appellants have waived any argument thereto.

SUMMARY

The rejection of claims 25, 26, and 28-33 under 35 U.S.C. § 102 is reversed.

The rejection of claim 27 under 35 U.S.C. § 103 is reversed

A new ground of rejection of claims 25, 26, and 28-33 under 35 U.S.C. § 102 has been entered.

A new ground of rejection of claim 27 under 35 U.S.C. § 103 has been entered.

37 C.F.R. § 41.50(b) provides “[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review.”

Appeal 2009-006049
Application 10/792,178

37 C.F.R. § 41.50(b) also provides that Appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new grounds of rejection to avoid termination of the appeal as to the rejected claims:

(1) *Reopen prosecution.* Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the Examiner, in which event the proceeding will be remanded to the Examiner. . . .

(2) *Request rehearing.* Request that the proceeding be reheard under § 41.52 by the Board upon the same record. . . .

Should Appellants elect to prosecute further before the Examiner pursuant to 37 C.F.R. § 41.50(b)(1), in order to preserve the right to seek review under 35 U.S.C. §§ 141 or 145 with respect to the affirmed rejection, the effective date of the affirmation is deferred until conclusion of the prosecution before the Examiner unless, as a mere incident to the limited prosecution, the affirmed rejection is overcome.

If Appellants elect prosecution before the Examiner and this does not result in allowance of the application, abandonment or a second appeal, this case should be returned to the Board of Patent Appeals and Interferences for final action on the affirmed rejection, including any timely request for rehearing thereof.

REVERSED – 37 C.F.R. § 41.50(b)

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Appeal 2009-006049
Application 10/792,178

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